



AF / 3728

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : KEVIN H. GILLESPIE  
Serial No. : 09/788,147  
Filed : February 16, 2001  
Title : SHOE OUTSOLE

Art Unit : 3728  
Examiner : Marie D. Patterson

**Mail Stop Appeal Brief - Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

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REPLY BRIEF

Pursuant to 37 CFR 1.193(b)(1), Appellant responds to the new points raised in the Examiner's Answer as follows.

At page 2, paragraph 2 of the Examiner's Answer, the Examiner notes that Appellant's Appeal Brief does not include a statement identifying related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal. Appellant respectfully submits that this is incorrect. At page 1, paragraph 2 of the Appeal Brief, Appellant states that there are no pending related appeals or interferences. Appellant states further that the above-referenced statement remains true at the time of filing this Reply Brief.

At page 7, paragraph 11 in the Examiner's Answer, the Examiner states, with respect to the rejections made in view of Schenkel, that Webster's Dictionary defines "flow" as follows: "to deform under stress without cracking or rupturing." As Appellant noted in the Appeal Brief, this definition is listed seventh out of eight possible definitions for the word "flow" in Webster's Dictionary, and is said to be "used especially of minerals and rocks." The definition arbitrarily selected by the Examiner is certainly not

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the meaning of the term “flow” as used by the Appellant. Nor is this the meaning that a skilled artisan would assign to the term “flow” when read in the context of Appellant’s specification.

At page 7, paragraph 11 of the Examiner’s Answer, the Examiner further states, “It is not understood what other definition of [“]flow[”] [*sic*] applicant is arguing or what specific limitations applicant is intending on encompassing with the term ‘flow.’” As specifically noted in the Appeal Brief, Appellant submits that the appropriate definition of the term “flow” as used in the application is Webster’s Dictionary’s definition 1(b): “to move with a continual change of place among the constituent particles<the molasses *flowed* smoothly>.” When the term “flow” is defined appropriately in light of Appellant’s specification and its common meaning, it is clear that the Schenkel insole cannot fairly be said to “flow” in the way the term is used in Appellant’s claims.

At page 7, paragraph 11 of the Examiner’s Answer, the Examiner also argues that, “under extreme circumstances,” Appellant’s “cushion would protrude through the apertures to a great extent and may, even though undesired, contact the ground.” In an effort to prop up this argument, the Examiner cites Appellant’s disclosure at page 6, lines 18-25, which reads, “The extent that the cushion 70 protrudes through the apertures 42 and 44 depends on the wearer’s weight and the force of the heel strike.” Searching further for support of her position, the Examiner contends “there is no structure or specific guidelines that would ensure that Appellant’s cushion would not contact the ground under extreme conditions.”

Appellant respectfully disagrees with the Examiner’s position. The mere fact that the extent of protrusion of Appellant’s cushion depends on the wearer’s weight and the force of heel strike does not warrant the conclusion, as the Examiner contends, that Appellant’s cushion would contact the ground under even extreme conditions of use. Furthermore, the Examiner fails to take into account Appellant’s statement at page 6, lines 19-21 of the specification, which reads, “Since recessed portion 40 on lower surface 20 of outsole 10 is spaced from the ground, the portion of cushion 70 protruding through apertures 42 and 44, even when force is applied to the cushion, does not contact the ground.” Importantly, Appellant explicitly recites in the claims that the lower cushion

surface is “spaced by said recessed wall surface of said outsole above the floor or ground surface at all times.” There is no justification, nor basis, for the Examiner to simply ignore the express limitation of Appellant’s claim that the cushion is spaced above the floor or ground surface at all times. The Appellant’s disclosure, taken in full, rather than in carefully selected, piecemeal snippets, makes it abundantly clear that Appellant’s cushion remains spaced from the floor or ground surface at all times. Furthermore, as Appellant noted in the Appeal Brief, the recessed wall surface of the outsole of Appellant’s shoe provides the requisite structure for maintaining the claimed spacing.

At page 7, paragraph 11 of the Examiner’s Answer, the Examiner contends that the material of Schenkel and/or Fuerst is polymeric and considered to be “gelatinous.” Appellant respectfully disagrees. Schenkel teaches an insert made from ethyl vinyl acetate and polyurethane. Fuerst teaches an insert made from thermoset polyurethane foam. As Appellant noted in the Appeal Brief, there is simply no indication that Schenkel or Fuerst provided these materials in a gelatinous form. Furthermore, the mere fact that a material is capable of protruding and bulging, taken alone, does not support a conclusion that the material is gelatinous, as the Examiner argues. Therefore, it was error for the Examiner to assert that the materials disclosed in Schenkel and Fuerst are gelatinous.

At page 8, paragraph 11 of the Examiner’s Answer, the Examiner maintains the argument that Fuerst’s shoe inherently possesses the characteristic that the lower cushion surface remains spaced from the floor or ground surface at all times. In support of this position, the Examiner argues that the lower cushion remains spaced from the ground “if the wearer does not at any time provide excessive force...such as merely walking.” Appellant respectfully disagrees with the position and the reasoning of the Examiner. First, the fact that a certain result or characteristic may occur or may be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(emphasis added). Second, because the sole taught by Fuerst is particularly adapted for use with athletic shoes, e.g., for basketball and the like (Fuerst, col. 1, lines 36-37), it would be unreasonable to expect that the Fuerst shoe would not be regularly used for jumping, running, and other physical activities commonly associated with the play of basketball

and other athletics, thus resulting in frequent heel strike. Third, as noted in the Appeal Brief, Fuerst states repeatedly, in no uncertain terms, that his shoe is designed specifically so that the dome-shaped portion will contact the floor or ground. For these reasons, the spacing of Appellant's claims cannot properly be considered an inherent feature of Fuerst.

At page 8, paragraph 11 of the Examiner's Answer, the Examiner also argues that Appellant's claimed product and Fuerst's product differ in function only, rather than structure. The Examiner cites Ex parte Masham, 2 USPQ2d 1647 (1987) for the legal position that "a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the *structural* limitations of that claim." Id. at 1648. In Ex parte Masham, the Board of Patent Appeals and Interferences affirmed an Examiner's position that a claim was anticipated by a prior art reference that taught each and every structural limitation of the claimed apparatus, but taught a slightly different manner of employing the apparatus. The claim at issue was directed to an apparatus for mixing developer material, and read in part, "said mixing means being...completely submerged in the developer material." The prior art reference taught the same structure, but its mixing means were only partially submerged in the developer material. In affirming the Examiner's position, the Board held that the recitation "completely submerged in the developer material" did not impose any structural limitations upon the claimed apparatus that differentiated it from the prior art reference.

In sharp contrast to the apparatus in Ex parte Masham, Appellant claims a structural limitation that is lacking from the prior art reference (i.e., Fuerst), rather than a mere functional limitation. Appellant's claim reads in part as follows:

said lower cushion surface of said first cushion, exposed at the aperture within said recessed region, being *spaced by said recessed wall surface of said outsole above the floor or ground surface at all times*, including when said first cushion deforms and flows under the wearer's weight and force of heel strike (emphasis added).

Without question, this clause includes structural limitations (e.g., "spaced by said recessed wall surface of said outsole above the floor or ground surface at all times") that

cannot simply be ignored by the Examiner. If these limitations are given patentable weight – as they must be – the Examiner’s rejection is baseless and Applicant’s claims are clearly not anticipated by Fuerst.

At page 8, paragraph 11 of the Examiner’s Answer, the Examiner further contends that Fuerst is clearly capable of performing the function “said lower cushion surface of said first cushion...being spaced by...at all times.” Appellant respectfully disagrees. There is simply no indication that the Fuerst shoe would or could perform in this manner. In fact, as noted in Appellant’s Appeal Brief, the Fuerst shoe is specifically designed with the intention that its dome-shaped portion will make contact with the floor or ground surface when the shoe is in use. Not only does Fuerst fail to teach the claimed spacing feature of Appellant’s shoe, Fuerst expressly teaches away from the claimed spacing feature.


Finally, at page 9, paragraph 11 of the Examiner’s Answer, the Examiner argues that the helium inflated silicone cushion of Pavone inherently bulges, flows, is forced down through the aperture in hard rubber sole. Appellant respectfully disagrees. There is simply no indication that Pavone’s shoe operates in this manner. Pavone teaches movement of the helium between adjacent chambers to provide cushioning for the user’s foot. (Pavone, col. 2, lines 13-25). Pavone provides no teaching or suggestion that the cushion bulges or protrudes through apertures in the hard rubber sole.

For these reasons, and the reasons stated in the Appeal Brief, Appellant submits that the final rejection should be reversed.

No fees are believed to be due at this time, however, please apply any charges, or any credits, to Deposit Account No. 06-1050.

Respectfully submitted,

Date: March 30, 2004

  
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